

REMARKS

Reconsideration of the above-identified application as amended is requested. Claims 1-9, 13-19 and 22-23 are in this application. The claims have been amended in accordance with the Examiner's suggestions. Claims 22 and 23 have been added and are directed to similar subject matter as cancelled claims 11 and 12.

Objection to Claims 1-8, 10-12 and 14-21

Claim 1 has been amended to insert the term "A" prior to the combination; claims 2-7 and 14-17 have been amended to insert the term "The" prior to combination and claims 8, 10-12 and 18-21 have replaced "a combination" with "the combination". Accordingly, the objection to the claims should be withdrawn.

Rejection of claims 11-12 and 20-21 under 35 U.S.C. §101

Claims 11-12 and 20-21 have been canceled. Accordingly, the rejection of these claims has been rendered moot and should be withdrawn.

Rejection of claims 1-21 under 35 U.S.C. §112, second paragraph

Claims 1-21 have been rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite. Each and every point raised by the Examiner has been addressed by the present amendment to the claims. The only point requiring explanation is the Examiner's contention that the metes and bounds of the Markush group in claim 6 are not clear with respect to "sulphonyl urea derivatives". Applicants respectfully traverse this rejection. It is well settled that an applicant can be his own lexicographer. Page 4, last full paragraph clearly defines "sulphonyl urea derivatives". Accordingly, this term is clear and the metes and bounds of claim 6 are definite. The claims are now definite enough to satisfy the statute and the rejection under 35 U.S.C. §112, second paragraph has been traversed and should be withdrawn.

Rejection of claims 3, 11, 13 and 20 under 35 U.S.C. §112, first paragraph

Solely to advance prosecution and without commenting on the propriety of this rejection, claims 3, 11, 13 and 20 have been amended such that prevention and delaying progression of metabolic diseases are no longer part of the claims. Applicants have amended the claims without prejudice to presenting the deleted subject matter in one or more continuing or divisional applications. Accordingly, this rejection has been rendered moot and should be withdrawn.

Rejection of claims 1-4 and 15 under 35 U.S.C. §102(e)

Claims and have been rejected under 35 U.S.C. §102(e) over U.S. Patent No. 6,432,969 to Villhauer ('Villhauer'). Applicants respectfully traverse this rejection. Applicants

respectfully submit that Villhauer is not prior art to the present application under 35 U.S.C. §102(e). Applicants have amended the specification in the instant amendment to claim priority to two U.S. provisional applications filed in October of 1999. The filing date of Villhauer was June 12, 2001 which claimed priority to a provisional application filed June 13, 2000. Applicants earliest date, October 1999, is prior to the earliest filing date of Villhauer. Accordingly, Villhauer is not prior art to the present application. Applicants set forth this priority claim by making reference to the earlier filed provisional application in the Application data sheet filed with the application. Due to this, the above claim for priority under 35 U.S.C. §119(e) has been timely made.

Therefore, The rejection of claims and under 35 U.S.C. §102(e) over has clearly been traversed and should be withdrawn.

The art of record pointed out by the Examiner is noted.

In view of the foregoing, Applicant submits the Application is now in condition for allowance and respectfully requests early notice to that effect.

Novartis
Corporate Intellectual Property
One Health Plaza, Building 430
East Hanover, NJ 07936-1080
(862) 778-7831

Respectfully submitted,



Gregory D. Ferraro
Attorney for Applicants
Reg. No. 36,134

Date: November 7, 2003